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09/810,515	03/15/2001	Cheng Zhou	T00070	6192
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EXAMINER				
VIG, NARESH				
ART UNIT		PAPER NUMBER		
3629				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tmunoz@hamiltontertile.com

Office Action Summary

Application No.

09/810,515

Applicant(s)

ZHOU ET AL.

Examiner

NARESH VIG

Art Unit

3629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in reference to communication received 08 October 2008. Claims 1 – 10 and 13 – 108 are pending for examination.

Response to Arguments

In response to applicant's argument that cited references do not teach at least one of the component-to-component relationships [included in the rules] identifies under what circumstances to include a first document component in the document when a second document component is included in the document."

However, cited references do teach rules based generating of documents. For example, Miller reference teaches generation of documents by adding or substituting of content of documents to ensure that the generated documents are valid in the state of the entity for whom the documents are generated [Miller, col. 3, lines 42 – 48]. Also, adding additional components is old and know business practice. For example, in a real estate transaction, for homes built prior to 1979, when Lead Paint Disclosure is added to the contract, EPA Pamphlet "Protect Your Family From Lead In Your Home" is added to the document to meet Federal Requirements. Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify to combine prior art elements according to known methods to yield predictable results.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 10 and 13 – 108 are not patentable because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, A "process" under § 101 must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing or (3) the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility, furthermore, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity². If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to nonstatutory subject matter. Moreover, the recitation of "computer implemented" in the preamble with the absence of a computer in the body of the claim or a lack of "another statutory class" in the body of the claim does not make the claim statutory.

As currently claimed, In the method claims 1, 15, 29 and dependent claims therefrom, and, in computer program claims 35, 52, 66 and dependent claims therefrom, applicant has not positively claimed whether the computer system perform

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)

² *The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. Gottschalk v. Aenson*, 409 U.S. 63, 71 (1972), *In re Bilski*, Fed. Cir. 2007-1130

the recited or the computer program when executed on a computer enables the computer to perform the limitations as recited in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 10 and 13 – 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. US Patent 5,446,653 in view of Shirley et al. US Patent 5,692,206 and Constantino US Patent 7,007,227.

Regarding claims 1, 6, 35 and 40, Miller teaches in a computer system executing a computer program code, a method for generating documents. Miller teaches:

receiving input data that includes information useful for generating a document from a plurality document components;

in response to receiving the input data, processing rules to determine which of one or more document components of the plurality of document components to include in a document (Miller, Each rule set provides at least one rule that must be satisfied in order to include the clause associated therewith in a document) [Miller, abstract],

wherein the rules include component-to-component relationships and at least one of the component-to-component relationships identifies under what circumstances to include a first document component in the document when a second document component is included in the document; **In addition, adding additional components is old and know business practice. For example, in a real estate transaction, for homes built prior to 1979, when Lead Paint Disclosure is added to the contract, EPA Pamphlet "Protect Your Family From Lead In Your Home" is added to the document to meet Federal Requirements. Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify to combine prior art elements according to known methods to yield predictable results.**

Miller does not exclusively teach obtaining each of the plurality of document components to be included in the document as determined by the processing of the rules. However, Shirley teaches computer implemented method for generation of various legal documents related to a negotiated agreement [Shirley, abstract]. Shirley teaches obtaining each of the plurality of document components to be included in the document as determined by the processing of the rules (The contract generation system also includes alternate provisions that can replace provisions in the standard documents, as well as supplemental and additional provisions that can be added to the standard documents)

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Miller by adopting teaching of Shirley to automate the generation of customized documents.

Miller in view of Shirley teaches capability for:
generating said document to include each of the obtained document components; and
making said document available to a user

Miller in view of Shirley does not exclusively recite using a model to generate a document. However, Constantino teaches Contracts and statements of work (SOW) are created in a document assembler using model agreements, alternate clauses, and supplemental provisions [Constantino, abstract]

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Miller in view of Shirley by adopting teachings of Constantino to have a base document which can be modified to customized for plurality of agreements.

Miller in view of Shirley and Constantino teaches capability for using a model to generate documents.

Regarding claims 15, 19, 52 and 56, as responded to earlier in response to claims 1 and 35, Miller in view of Shirley teaches in a computer system executing a computer program code, a method for generating documents. Even though Miller in view of Shirley does not specifically recite compensation component, however, it is known at the time of invention to one of ordinary skill in the art, compensation can be one of a critical component in a negotiated agreement.

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Miller in view of Shirley by providing compensation component

to document in a negotiated document a Memorandum of Understanding (MOU) with compensation terms and schedules.

Miller in view of Shirley teaches capability for:

receiving selection inputs selecting a compensation component and a textual component;

in response to receiving the selection inputs, processing rules to determine which of one or more components of a plurality of components to include in a document in addition to the compensation component and the textual component, wherein the rules include component-to-component relationships and at least one of the component-to-component relationships identifies under what circumstances to include a first component in the document when a second component is included in the document;

obtaining the compensation component, the textual component, and each of the plurality of components to be included in the document as determined by the processing of the rules; and

generating said document to include each of the obtained components

Miller in view of Shirley does not exclusively recite using a model to generate a document. However, Constantino teaches Contracts and statements of work (SOW) are created in a document assembler using model agreements, alternate clauses, and supplemental provisions [Constantino, abstract]

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Miller in view of Shirley by adopting teachings of Constantino to have a base document which can be modified to customized for plurality of agreements.

Miller in view of Shirley and Constantino teaches capability for using a model to generate documents.

Regarding claims 29 and 66, as responded to earlier, Miller in view of Shirley teaches in a computer system executing a computer program code, a method for enabling a user to define configurable documents comprising. Miller in view of Shirley does not exclusively recite using a model to generate a document. However, Constantino teaches Contracts and statements of work (SOW) are created in a document assembler using model agreements, alternate clauses, and supplemental provisions [Constantino, abstract]

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Miller in view of Shirley by adopting teachings of Constantino to have a base document which can be modified to customized for plurality of agreements.

Miller in view of Shirley and Constantino teaches capability for:

presenting a modeling interface to a user, wherein the modeling interface comprises a computer generated graphical user interface;

obtaining modeling information from said user via said modeling interface;

generating at least one compensation plan from said modeling information;

generating at least one compensation component by creating a relation between each of said at least one compensation plan and at least one product;

obtaining at least one textual element;

generating at least one textual component comprising said at least one textual element by creating a relation between each of said at least one textual component and said at least one product;

including respective rules associated with the compensation component and the textual component in a document template, wherein the rules are executable by a configuration engine, and the rules include component-to-component relationships and at least one of the component-to-component relationships identifies under what circumstances to include a first component in the document template when a second component is included in the document template and controlling how a configuration engine processes the document template to configure a document with one or more of the components; and

associating said at least one compensation component and said at least one textual component with the document template.

Regarding claims 2, 16, 36 and 53, Miller in view of Shirley and Constantino teaches capability wherein configuration engine performs said generating said document.

Regarding claim 3 and 37, Miller in view of Shirley and Constantino teaches capability wherein document components comprises a compensation document component.

Regarding claims 4, 17, 38 and 54, Miller in view of Shirley and Constantino teaches capability wherein document component defines a commission associated with the sale of a product.

Regarding claims 5, 18, 39 and 55, Miller in view of Shirley and Constantino teaches capability wherein commission comprises monetary compensation to be distributed to a sales representative.

Regarding claims 6, 19, 40 and 56, Miller in view of Shirley and Constantino teaches capability wherein compensation document component is modeled using a commission model.

Regarding claims 7 and 41, Miller in view of Shirley and Constantino teaches capability wherein document components comprises a textual document component.

Regarding claims 8, 20, 42 and 57, Miller in view of Shirley and Constantino teaches capability wherein textual document component comprises pre-defined textual elements.

Regarding claims 9 and 43, Miller in view of Shirley and Constantino teaches capability wherein pre-defined textual elements are extensible.

Regarding claims 10, 21, 22, 44, 58 and 59, Miller in view of Shirley and Constantino teaches capability wherein textual document component is a contractual clause and the document is a contract.

Regarding claims 13, 27 and 64, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationship comprises a requires relation.

Regarding claims 14, 28 and 65, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationship comprises an optional relation.

Regarding claims 23 and 60, Miller in view of Shirley and Constantino teaches capability wherein textual component is defined by a first user.

Regarding claims 24, 47, 61 and 74, Miller in view of Shirley and Constantino teaches capability wherein a document component is defined as a required component.

Regarding claims 25 and 62, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationships comprise an includes relation.

Regarding claims 26 and 63, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationships comprise an excludes relation.

Regarding claims 30 and 67, Miller in view of Shirley and Constantino teaches capability for:

providing said document template to said configuration engine; and
processing said rules of said document template by said configuration engine to generate a document.

Regarding claims 31 and 68, The method of claim 30 wherein said processing comprises:

obtaining one or more of the rules associated with said at least one compensation component and said at least one textual component from said document template;

applying said one or more rules to generate a document; and making said document available to a user.

Regarding claims 32 and 69, Miller in view of Shirley and Constantino teaches capability wherein rules comprises an includes rule.

Regarding claims 33 and 70, Miller in view of Shirley and Constantino teaches capability wherein rules comprises an excludes rule.

Regarding claim 34 and 71, Miller in view of Shirley and Constantino teaches capability wherein rules comprises a requires rule.

Regarding claims 45 and 73, Miller in view of Shirley and Constantino teaches capability wherein document comprises a contract.

Regarding claim 46, Miller in view of Shirley and Constantino teaches capability wherein document comprises any document associated with a business transaction.

Regarding claim 48, Miller in view of Shirley and Constantino teaches capability wherein interrelationship comprises an includes relation.

Regarding claim 49, Miller in view of Shirley and Constantino teaches capability wherein document component-to-document component relationships comprise an excludes relation.

Regarding claim 50, Miller in view of Shirley and Constantino teaches capability wherein document component-to-document component relationships comprise a

requires relation.

Regarding claim 51, Miller in view of Shirley and Constantino teaches capability wherein document component-to-document component relationships comprise an optional relation.

Regarding claim 72, Miller in view of Shirley and Constantino teaches capability wherein rules comprises an optional rule.

Regarding claim 75, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationships comprise an includes relation.

Regarding claim 76, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationships comprise an excludes relation.

Regarding claims 77, 85, Miller in view of Shirley and Constantino teaches capability for:

receiving second input data that includes additional information useful for generating the document from the plurality document components, wherein the second input data indicates selection of a third document component to be included in the document;

in response to receiving the second input data, processing the rules to determine which, if any, of one or more document components of the plurality of document components to also include in the document; and

obtaining the third document component and each of the plurality of document components to be included in the document as determined by the processing of the rules.

Regarding claims 78, 86, Miller in view of Shirley and Constantino teaches capability wherein:

receiving additional inputs of data, wherein the additional inputs of data indicate selections of additional document components to be included in the document;

in response to receiving the additional inputs of data, processing the rules to determine which, if any, of one or more document components of the plurality of document components to also include in the document; and

obtaining the additional document components and each of the plurality of document components to be included in the document as determined by the processing of the rules.

Regarding claims 79, 87, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationships identifies a 'requires choice' component-to-component relationship further comprising:

in response to the processing of the rules, requesting a user to select one document component, from a group of document components identified by the requires choice component-to-component relationship to include in the document.

Regarding claims 80, 88, Miller in view of Shirley and Constantino teaches capability wherein :

at least one of the component-to-component relationships identifies an 'includes' component-to-component relationship;

receiving input data further comprises receiving a selection of a third document component; and

obtaining each of the plurality of document components to be included in the document as determined by the processing of the rules further comprises obtaining the third document component and a fourth document component identified in the includes component-to-component relationship.

Regarding claims 81, 89, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationships identifies an 'optional' component-to-component relationship, further comprising:

in response to the processing of the rules, providing a user an option to select one or more document components, from a group of document components identified by the optional component-to-component relationship; and

wherein obtaining each of the plurality of document components to be included in the document as determined by the processing of the rules further comprises obtaining each document component selected by the user in response to providing the user the option to select the one or more document components.

Regarding claims 82, 90, Miller in view of Shirley and Constantino teaches capability wherein component-to-component relationships identifies a 'removes' component-to-component relationship and wherein receiving a selection input data further comprises receiving a selection of a third document component, further comprising removing one or more document components from inclusion in the document.

Regarding claims 83, 91, Miller in view of Shirley and Constantino teaches capability wherein input data comprises selection of a particular contract type.

Regarding claims 84, 92, Miller in view of Shirley and Constantino teaches capability wherein document components and component-to-component relationships are included in a document template.

Regarding claims 93 and 101, Miller in view of Shirley and Constantino teaches computer program which is configured with the capability to:

access second input data that includes additional information useful for generating the document from the plurality document components, wherein the second input data indicates selection of a third document component to be included in the document;

in response to accessing the second input data, process the rules to determine which, if any, of one or more document components of the plurality of document components to also include in the document; and

obtain the third document component and each of the plurality of document components to be included in the document as determined by the processing of the rules.

Regarding claims 94 and 102, Miller in view of Shirley and Constantino teaches computer program which is configured with the capability to:

access additional inputs of data, wherein the additional inputs of data indicate selections of additional document components to be included in the document;

in response to accessing the additional inputs of data, process the rules to determine which, if any, of one or more document components of the plurality of document components to also include in the document; and

obtain the additional document components and each of the plurality of document components to be included in the document as determined by the processing of the rules.

Regarding claims 95 and 103, Miller in view of Shirley and Constantino teaches computer program which is configured with the capability wherein at least one of the component-to-component relationships identifies a 'requires choice' component-to-component relationship, the code is further configured with the capability to:

in response to the processing of the rules, request a user to select one document component, from a group of document components identified by the requires choice component-to-component relationship to include in the document.

Regarding claims 96 and 104, Miller in view of Shirley and Constantino teaches computer program which is configured with the capability wherein:

at least one of the component-to-component relationships identifies an 'includes' component-to-component relationship;

the code configured to access input data further comprises accessing a selection of a third document component; and

the code configured to obtain each of the plurality of document components to be included in the document as determined by the processing of the rules further comprises obtaining the third document component and a fourth document component identified in the includes component-to-component relationship.

Regarding claims 97 and 105, Miller in view of Shirley and Constantino teaches computer program which is configured with the capability to wherein at least one of the

component-to-component relationships identifies an 'optional' component-to-component relationship, the code is further configured with the capability to:

in response to the processing of the rules, provide a user an option to select one or more document components, from a group of document components identified by the optional component-to-component relationship; and

wherein the code configured to obtain each of the plurality of document components to be included in the document as determined by the processing of the rules further comprises obtaining each document component selected by the user in response to providing the user the option to select the one or more document components.

Regarding claims 98 and 106, Miller in view of Shirley and Constantino teaches computer program which is configured with the capability wherein component-to-component relationships identifies a 'removes' component-to-component relationship and wherein the code configured to access input data further comprises accessing a selection of a third document component, the code is further configured with the capability to remove one or more document components from inclusion in the document.

Regarding claims 99 and 107, Miller in view of Shirley and Constantino teaches computer program which is configured with the capability wherein the selection input data comprises selection of a particular contract type.

Regarding claims 100 and 108, Miller in view of Shirley and Constantino teaches capability wherein the plurality of document components and component-to-component relationships are included in a document template.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Protect Your Family From Lead In Your Home

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 02, 2009

/Naresh Vig/
Primary Examiner, Art Unit 3629